

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILFRIED LUSTIG

Appeal No. 1997-4374
Application No. 08/317,679¹

HEARD: October 6, 1999

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS,
and GONZALES, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed October 5, 1994.

This is a decision on an appeal from the examiner's final rejection of claims 6 through 11. No other claims are pending in the application.

Appellant's claimed invention relates to an angle joint for chassis parts in a motor vehicle. The angle joint comprises a housing (1), a shaft (2) attached to the housing by contour welding (3) and a joint pivot or "inner part" (4), as it is called in the appealed claims and appellant's specification, supported in the housing for universal movement by an elastomeric body 5. The inner part and the shaft are connectable to different chassis parts. According to the independent claims on appeal, namely claims 6 and 7, the housing is cold extruded and the shaft is forged.

A copy of the appealed claims is appended to appellant's brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Buhl
1989

4,883,263

Nov. 28,

Australian Patent	154,916	Jan. 15,
1953		
(Alford & Alder)		

In addition, the examiner has cited for the first time in the answer (see page 3) the following references "as evidence of the Official Notice taken in the rejection in this examiner's answer" (answer, page 3):

Hasler et al. (Hasler)	4,618,163	Oct. 21,
1986		

R.C. Dorf, Robotics and Automated Manufacturing, pp. 126-127 (1983)

Claims 6 through 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Buhl patent in view of the Australian patent. In support of this rejection, the examiner states:

It would have been obvious to a person of ordinary skill in the art at the time of appellant's invention to modify the type of connection of Buhl to be a contour type weld in view of [the Australian Patent] in order to provide a strong, yet low cost connection between the shaft and housing. As concerns the limitations of a *cold extruded* housing and a *forged* shaft, these are product by process limitations and are not given patentable weight; the claimed subject matter is drawn to a product, namely an angle joint, and not a

process of making the joint. Moreover, the examiner takes Official Notice that cold extrusion and forging processes are well known in the art, and it is possible for the housing of Buhl to be manufactured by a cold extrusion process and the shaft by a forging process. As evidence of the Official Notice taken above, the Examiner cites Hasler et al. 4,618,163. Hasler et al. shows automotive chassis in which an extruded member is welded to a forged member (Col 3, lines 58-60; Col 4, lines 1-4; Col 3, lines 24-27). As evidence of the motivation of providing a strong, yet low cost connection between the shaft and housing, the [Australian] reference and the excerpt from the book Robotic and Automated Manufacturing, is cited (emphasis in the original; answer, page 4).

We cannot sustain the appealed rejection. In the first place, there is no teaching in the Australian patent or any of the other cited references, for that matter, of dividing Buhl's one piece housing and shaft structure (1, 2) into separate housing and shaft parts and then contour welding those parts together. In this regard, there is no evidence of record that a contour welded connection between separately formed housing and shaft parts would be stronger than the unitary connection in Buhl's one piece housing and shaft structure to provide the motivation for dividing Buhl's one piece structure into

separate housing and shaft components and then contour welding those components together.

Furthermore, according to the evidence presented by appellant (see page 672 in volume 12 of the Encyclopedia Britannica), cold working alters the grain structure of the metal to produce a finer grained metal. Thus, there is unchallenged evidence that cold-extruding the housing structurally alters the housing to distinguish the final product from the prior art. The method limitation of cold extruding the housing must therefore be given weight in determining the patentability of the appealed claims under the holding in In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981).

None of the applied references, namely the Buhl and Australian patents, teaches or suggests the concept of cold extruding any part let alone the housing of an angle joint as called for in the independent claims.

We are not unmindful of the citation of the Hasler reference in the examiner's answer to support his position that

cold extrusion and forging processes are "well known in the art" (answer, page 4). The question presented by the appealed claims, however, is not whether cold extrusion and forging processes are known in the art, for it is well established that the mere existence of individual features in the prior art is not in itself sufficient basis to render a claimed invention obvious under § 103. See Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 199 (Fed. Cir. 1983). Instead, the question is whether appellant's combination including the cold extruded housing would have been obvious under § 103. The fact that it may be "possible" that Buhl's housing could be cold extruded as discussed on page 4 of the answer does not make such a modification obvious. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior suggest the desirability of the modification."). We find no such suggestion in the prior art cited by the examiner.

For the foregoing reasons the examiner's decision rejecting appealed claims 6 through 11 is reversed.

REVERSED

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)
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NEAL E. ABRAMS)
Administrative Patent Judge)

JOHN F. GONZALES)
Administrative Patent Judge)

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